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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09.489,884	01/21/2000	Terry R. Colbert	P04348US0-PHI-1194	6401

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EXAMINER

KRUSE, DAVID H

ART UNIT PAPER NUMBER

1638

DATE MAILED: 04/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/489,884

Applicant(s)

COLBERT, TERRY R.

Examiner

David H Kruse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 11, 15, 19, 24, 28 and 32 is/are rejected.
- 7) ☐ Claim(s) 1-6, 8-10, 12-14, 16-18, 20-23, 25-27 and 29-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

STATUS OF THE APPLICATION

1. This Office Action is in response to the Amendment and Remarks filed 18 January 2002.
2. The objection to claim 10 is withdrawn in view of Applicant's amendment to the claim.
3. The rejection of claims 6, 7, 10, 11, 14, 15, 18, 19, 23-25, 27-29, 31 and 32 under 35 U.S.C. § 112, second paragraph, as indefinite is withdrawn in view of Applicant's amendments to the claims.
4. The rejection of claims 1-6 and 8-32 under 35 U.S.C. § 103(a), as being unpatentable over Cunnyingham is withdrawn in view of Applicant's arguments.

DETAILED ACTION

Claim Objections

5. Claims 1 and 5 remain objected to for the reason of record given in the last Office Action concerning the ATCC accession number designation in the claims. Consequently, those claims to which the instant claims are dependent are objected to as being dependent upon a claim that remains objected to. The Examiner notes that Applicant has stated that the deposit of the corn hybrid designated '33T17' will be perfected at the time when the application is in condition for allowance. In addition, Applicant states the conditions under which the said ATCC deposit will be made on page 6 of the Remarks, filed 18 January 2002.

Claim Rejections - 35 USC § 103 and §§ 102/103

6. Claim 7 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Cunnyingham (US Patent 6,087,564, filed 13 February 1998). This rejection is repeated for the reason of record as set forth in the last Office action mailed 3 July 2001. Applicant's arguments filed 18 January 2002 have been fully considered but they are not persuasive.

Applicant argues that any phenotypic trait that is expressed in the claimed plants is a result of a combination of all of the genetic material present in the 33T17 plant and will have its own unique genetic profile that will contribute to a breeding program (page 8, third paragraph of the Remarks). The Examiner responds that the regenerated corn plant may comprise somoclonal variations that would not be present in the plant from which the original tissue culture was produced. Amendment of the claim to read as originally worded with the exception of replacing the phrase "capable of expressing" with the term -- expresses -- would obviate this rejection.

7. Claims 11, 15, 19, 24, 28 and 32 remain and amended claim 7 is rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Cunnyingham (US Patent 6,087,564, filed 13 February 1998). This rejection is repeated for the reason of record as set forth in the last Office action mailed 3 July 2001. Applicant's arguments filed 18 January 2002 have been fully considered but they are not persuasive.

Applicant argues that it would require undue experimentation to begin with the hybrid of Cunnyingham to recover a hybrid with at least two of the traits enumerated in

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the instant claims and that there is no expectation of success that the crossing of the hybrid of Cunnyingham with some yet to be identified plant would yield a plant with two of the traits enumerated in the claim (paragraph spanning pages 8-9 of the Remarks). The Examiner responds that undue experimentation is irrelevant to the instant rejection. The issue remains that the instant claims read on any plant comprising two '33T17' traits, traits that are not specifically unique to only the corn plant designated as '33T17', but which in fact occur in other corn plants, such as that taught by Cunnyingham. Given that Cunnyingham teaches at least two of the traits of '33T17', one of skill in the art would have had a reasonable expectation of success in transferring these traits.

Applicant argues that it must be recognized that the '33T17'-derived plants are themselves unusual and a nonobvious result of a combination of previously unknown and nonobvious genetics and that the phenotypic traits described, in each '33T17'-derived plant, has an additional benefit unique to each specific cross using '33T17' as one of its ancestors (page 9, second paragraph of the Remarks). The Examiner responds that one of skill in the art at the time of Applicant's invention would not be able to distinguish a maize plant having at least one ancestor being '33T17' and having at least two of the claimed traits from that taught by Cunnyingham for the reasons given in the last Office Action. Because there is no limitation in the instant claims directed to how many generations removed the claimed maize plant is from '33T17' taught by Applicant, the claimed maize plant could only comprise that genetic material from '33T17' that contributes to two of the claimed traits, but the remaining genetic material could be totally unrelated to '33T17', at which point one of skill in the art would not be

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able to recognize the source of the claimed traits. Alternatively, the claimed maize plant could retain no '33T17' genetic material, wherein the two claimed traits, expressed to the same degree as their expression in '33T17', could be the result of non-'33T17' genetic material.

Regarding amended claim 7, the claim now reads on somoclonal variant plants, indistinguishable from those of the prior art as discussed above, despite their altered method of production.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Claims 7, 11, 15, 19, 24, 28 and 32 are rejected.

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9. Claims 1-6, 8-10, 12-14, 16-18, 20-23, 25-27 and 29-31 are objected to. This objection will be withdrawn when all claims are allowable and the deposit of the hybrid maize seed designated '33T17' has been perfected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (703) 306-3218. The fax telephone number for this Group is (703) 872-9306 Before Final or (703) 872-9307 After Final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Kim Davis whose telephone number is (703) 305-3015.

David H. Kruse, Ph.D.
5 April 2002

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180- / 638

